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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,142	03/19/2004	Toshikazu Yabe	Q80622	6378

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EXAMINER

MULCAHY, PETER D

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/804,142

Applicant(s)

YABE ET AL.

Examiner

Peter D. Mulcahy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 7-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 7-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 7-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim language "ephr, in terms of acid equivalent weight" is indefinite. The "ephr" language is seen to identify the equivalent weight per 100 parts by weight. It is unclear as to how the "in terms of acid equivalent weight" further limits the claim.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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5. Claims 1, 7-12, 29-40 and 57-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. US 5,250,627 or Rau et al. US 6,187,867 in view of Mori et al. US 5,861,212.

6. Each of these patents extensively discusses molding compositions which incorporates the claimed carboxylated acrylonitrile-butadiene rubbers, see Yamamoto et al. at col. 3, lines 29+, and Rau et al. at col. 2, lines 10+. These patents further suggest the incorporation of the claimed polyolefin, see Yamamoto et al. at col. 3, lines 27+, and Rau et al. at col. 3, lines 1+. The incorporation of carbon black is suggested at Yamamoto et al. col. 4, lines 34+, and Rau et al. col. 4, lines 9+. The difference between the prior art and the claimed invention is the lack of an example, which anticipates each of the claimed limitations. The patents disclose each of applicants claimed ingredients and teaches that they be used in combination with each other. As such, one of ordinary skill in the art would have found the claimed invention prima facie obvious at the time of invention.

7. The amount of carboxyl groups as now set forth in claims 1, 7, and 8 is seen to be either anticipated or obvious from the polymers shown in the art. These are the same monomeric constituents in the same percentages. As such, they are considered to possess properties which either anticipate or render obvious the properties as claimed. Applicants simply allege that the art is silent as to this amount of carboxyl groups. This is not persuasive. The primary references identify carboxyl group containing nitrile polymers. These polymers may well possess the claimed amount of carboxyl groups. The fact that the art is silent to the amount of carboxyl groups is not

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dispositive. The art has a carboxyl content. Applicants have failed to show or allege that the carboxyl content of the prior art is outside the scope of that claimed. The examiner maintain that the claimed carboxyl content is conventional. It is considered to be obvious to select a carboxylated nitrile rubber having the carboxyl content as claimed because one of ordinary skill knows these rubbers and understands their properties. The Mori et al. patent is cited to further show the carboxylated nitrile having the claimed amount of carboxyl groups, see column 3, lines 30+. These are used in structural rubber applications and one would have a reasonable expectation of success when using the carboxylated nitrile rubber of Mori et al.

8. The "tension rupture" and "tensile rupture" properties as requisite claims 33-36 and 61-64 are seen to be either anticipated or obvious from the compositions shown in the art. These are the same monomeric constituents in the same percentages. As such, they are considered to possess properties which either anticipate or render obvious the properties as claimed.

9. Claims 18-28 and 46-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. US 5,250,627 or Rau et al. US 6,187,867 as applied to claims 1, 7-12, 29-40 and 57-64 above, and further in view of Ryoke et al. US 5,094,908 and further in view of Mori et al. US 5,861,212.

10. These claims further incorporate lubricants. These lubricants are known and are seen to be functioning in an art recognized manner. Ryoke et al. shows lubricants functioning in thermoplastic resins as claimed, see col. 5, lines 33+, and col. 7, lines 37+. It is prima facie obvious to use the lubricants shown in Ryoke et al. in the

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compositions of Yamamoto or Rau. The courts have well established that it is prima facie obvious to incorporate known ingredients and have them function in an expected manner.

11. Claims 13-17 and 41-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. US 5,250,627 or Rau et al. US 6,187,867 as applied to claims 1, 7-12, 29-40 and 57-64 above, and further in view of Sasaki et al. US 4,661,563 and further in view of Mori et al. US 5,861,212.

12. The various fillers claimed herein are known and are seen to be functioning in an art-recognized manner. Sasaki et al. shows fillers functioning in thermoplastic resins as claimed, see col. 3, lines 10+. It is prima facie obvious to use the fillers shown in Sasaki et al. in the compositions of Yamamoto or Rau. The courts have well established that it is prima facie obvious to incorporate known ingredients and have them function in an expected manner.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy whose telephone number is 571-272-1107. The examiner can normally be reached on Mon.-Fri. 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Peter D. Mulcahy  
Primary Examiner  
Art Unit 1713